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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,678	04/08/2004	Dean A. Cervenka	1816/40915/Case 2	8540

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EXAMINER

KLEBE, GERALD B

ART UNIT

PAPER NUMBER

3618

DATE MAILED: 01/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/820,678

Applicant(s)

CERVENKA, DEAN A.

Examiner

Gerald B. Klebe

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 7-9, 15, 16, 18-20, 23 and 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 12-14, 17, 21 and 25 is/are rejected.
- 7) ☒ Claim(s) 10, 11 and 22 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

G.B. Klebe
19 January 2006

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>07/19/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election / Restriction Response

1. Applicant's election without traverse filed 09/14/2005 of Species II, Figures 9-14 with claims 1-17, 21, 22, and 25 considered by Applicant to be reading thereon is acknowledged.

The examiner agrees with Applicant that claim 23 reads on non-elected species III, and agrees that claim 24 reads on non-elected species IV. However, the examiner disagrees with Applicant's assertion that claims 7-9, 15-16, and 18-20 read on the elected species II.

The examiner finds that claims 7-9 and 18-20 read on non-elected species I, that claim 15 reads on non-elected species III and that claim 16 reads on the non-elected species IV.

Consequently, claims 7-9, 15-16, 18-20, 23 and 24 reading on non-elected species are hereby withdrawn by the examiner from further consideration on the merits.

An examination on the merits follows of the remaining pending claims 1-6, 10-14, 17, 21-22 and 25, with claims 1, 17 and 21 being independent.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the structure recited in claim 14 wherein the step, as distinguished from the step assembly and/or the mounting member, includes a brace must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet,

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even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification Objections

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Claim 14 recites the limitation wherein the step includes a brace. However, this is not found to be supported by the disclosure, including the specification and drawings as filed, where it is disclosed and shown to the contrary that the structure known as the brace is a part of the mounting member of the step assembly and is not disclosed or shown to be a portion of the step.

Appropriate correction or clarification is required. No new matter should be added.

Claim(s) Objections

4. Claim 3 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of the previous claim, claim 1. Applicant is required to

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cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 3 recites the limitation "... wherein when the step assembly is not in use, at least a portion of the stepping member extends above at least a portion of the bumper of the vehicle". This recitation appears not to further limit the limitation recited in claim 1 from which claim 3 directly depends wherein claim 1 recites the limitation "... wherein the stepping member is placed in a generally vertical position when the step is not in use and is positioned higher than the bumper of the vehicle".

Claim Rejections - 35 USC 112, 2nd Paragraph

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 3 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Claim 3 recites the limitation: "... wherein when the step assembly is not in use, at least a portion of the stepping member extends above at least a portion of the bumper of the vehicle." Since the claim fails to further recite that when the step assembly is not in use it is furthermore considered as having been placed in a generally vertical position, it is not clear how the claim recitation could not be applied to a situation in which, although not being used, the step is not placed into a vertical position, in which case, clearly, the stepping member would not extend above at least a portion of the bumper of the vehicle.

Appropriate correction is required.

EXAMINER'S NOTE: It is the examiner's understanding that it is not the condition of the stepping member being not-in-use but instead, its condition of being in its vertical orientation that establishes the structural distinction wherein the height of the step is higher than the height of the bumper, so that the recitation that the step is not in use is irrelevant to a concise and exact statement of a limitation reciting the structural requirement of the inventive concept wherein the step is higher than the bumper.

b. Claim 14 recites that the step includes a brace; however, the step is distinguished in the claims from the step assembly and the mounting member and it appears that the brace is a portion of the mounting member rather than of the step.

Appropriate correction or clarification is required.

For the purposes of further examination on the merits the recitations of claim 14 will be interpreted by the examiner as if reciting that the step assembly includes a brace, the brace supporting a ball assembly.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-3, 12-13, 17 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hehr (US 6685204).

Hehr discloses a step assembly for attachment to a trailer hitch receiver of a vehicle including a bumper, the step assembly comprising:

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(re: **claim 1**) a mounting member (Fig 1, item 40) for engagement with the hitch receiver (Fig 2, item 50; refer col 5, lines 15-30 and col 6, lines 45-47), a step (42) pivotally attached to the mounting member (40; see Fig 2 and refer col 6, lines 51-55), the step (42) including a stepping member (taken as the top surface of 42), where the stepping member is placed in (**"pivoted to"** as recited in **claims 17 and 21**) a generally vertical position when the step is not in use (see Fig 2, and refer col 6, lines 51-55) and wherein the stepping member (top surface of 42) is placed in a generally horizontal position when the step is in use (shown in Figs 4 and 5); and

(re: **the further recitations of claims 17 and 21**) wherein the mounting member (40) includes a shaft for engagement with the trailer hitch receiver (as disclosed, item 40 represents a hollow tubular shaft of rectangular cross-section) and a pivoting axis (Fig 10, item 72) mounted to the mounting member (see Figs 10-14 and refer to the associated text beginning at col 8, line 10) and a step (42) pivotally attached (refer col 8, lines 18-21) to the pivot axis (72); and,

(re: **the further recitation of claim 21**) having a pivoting axis (72) extending through the shaft of the mounting member (40) providing pivotal engagement between the mounting member and the step (42) (see Figs 10-14 and refer col 8, lines 14-27); and,

wherein the stepping member is placed in (**"pivoted to"** as recited in **claim 17**; **"is in"** as recited in **claim 21**) a generally vertical position when not in use, and a generally horizontal position when in use.

Figures 2 and 3 show that the stepping member (taken as the top surface of the step 42) of Hehr is sized such that when the stepping member is positioned at ("pivoted to"; "in") the generally vertical position when not in use as a step, its height is below the height of the top of

the bumper rather than, as claimed, at least a portion of the stepping member being positioned higher than (“over” as recited in claim 17; “above” as recited in claim 21) the bumper.

However, it would have been obvious to one of ordinary skill in the art at the time the instant invention was made to have modified the disclosure of Hehr by increasing the size of the stepping member including to an extent that, when not in use its height would exceed that of the bumper’s top surface in order to provide a step having a larger top surface to be sized to support both a user and any bulk materials being loaded/unloaded thereby to reduce the vertical distance the user would have to lift the materials, since affecting a mere change in the size of an apparatus feature is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955); and,

(re: claim 2) wherein when the step assembly is used with a vehicle including a tail gate, at least a portion of the stepping member of the step extends beyond the tail gate of the vehicle when the tail gate is in a lowered position (see Fig 5); and,

(re: claim 3) wherein when the step assembly is not in use, at least a portion of the stepping member extends above at least a portion of the bumper of the vehicle (see Fig 5); and,

(re: claim 12) wherein the step further includes at least one anti-rack bumper (taken as the depending flange portion (item 92, shown in Figs 10-14; and refer col 8, lines 45-54 which, as best seen in Fig 14 prevents the step member 42 from pivoting past vertical when the step member is moved from its horizontal orientation for use as step to its vertical, non-use orientation); and,

(re: **claim 13**) the step (item 42) further including a shaft brace (item 94, Fig 10-14) which mates with the mounting member (40) and wherein the shaft brace abuts the mounting member to prevent rotation of the step beyond the generally horizontal position.

9. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hehr (US 6685204) in view of Hagen et al. (US 6491315).

As discussed above, Hehr discloses all of the features of claim 1 from which claim 4 depends.

Hehr lacks explicit disclosure wherein the step assembly further includes a brake light on the step in communication with a brake light of the vehicle.

However, Hagen et al. teaches a step assembly (Fig 1, item 10) for attachment to a trailer hitch receiver of a vehicle having a bumper (refer col 2, lines 50-53) wherein the step assembly further includes a brake light (item 28) on the step, the brake light being in communication with the brake light(s) of the vehicle (refer col 2, lines 43-45).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the instant invention was made to have modified the step assembly of Hehr to include on the step brake lights in communication with the brake lights of the vehicle in order to give following vehicles additional warning that a stop is being made as suggested by the reference at column 1, lines 57-60.

10. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hehr (US 6685204) in view of Nerem et al. (US 4116457).

As discussed above, Hehr discloses all of the features of claim 1 from which claims 5-6 depend.

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Hehr lacks explicit disclosure wherein the step assembly further includes a step light with means for activating such wherein the step light is mounted by a swivel bracket.

However, Nerem et al. teaches a vehicle step assembly including (re: **claim 5**) a step light (Fig 2, item 96) provided on the step and means for activating the step light (refer col 4, lines 34-36 and lines 57-62).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the instant invention was made to have modified the step assembly of Hehr to include a step light operable with means to illuminate the light when the step is used and turn the light off when the step is in its non-use stowed position as taught by Nerem et al. in order to provide a safety feature for the step.

11. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hehr (US 6685204) in view of Nerem et al. (US 4116457) and further in view of McCoy et al. (US 6783266).

As discussed above, the combination of Hehr and Nerem et al. teaches all of the features of claim 5 from which claim 6 depends.

The combination of Hehr and Nerem et al. lacks explicit disclosure wherein the step light is mounted by a swivel bracket.

However, McCoy et al. teaches a vehicle trailer hitch light mounted by a swivel bracket.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the instant invention was made to have modified the step assembly light of the combination of Hehr and Nerem et al. to be mounted using a swivel bracket as taught by McCoy et al. in order to better focus the light where best needed on the step.

Examiner's Note: Regarding that McCoy's light is mounted to the trailer hitch, it is obvious that when the step assembly is mounted to the vehicle via the trailer hitch receiver, the light can be considered as being mounted to or on the step and since it would have been obvious to one having ordinary skill in the art at the time the invention was made to have mounted the light wherever convenient and effective for illuminating the step as a matter of obvious design choice since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

12. Claims 14 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hehr (US 6685204) in view of McCoy et al. (US 6623025).

As discussed above, Hehr discloses all of the features of 1 from which claim 14 depends and of claim 21 from which claim 25 depends.

Regarding the further features of claims 14 and 25, Hehr lacks explicit disclosure wherein (re: claim 14) the step assembly includes a brace, the brace supporting a ball assembly and, (re: claim 25) and such that, therefore, the mounting member further includes a ball assembly.

However, McCoy et al. teaches an assembly for attachment to a trailer hitch receiver of a vehicle the assembly having a brace, the brace supporting the ball assembly, and such that, therefore, the mounting member includes a ball assembly.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the instant invention was made to have modified the mounting member of the step assembly of Hehr to include a ball assembly in accordance with the teachings of McCoy et al. in order to be able to further enable the assembly to further mount an article carrying accessory such as a bicycle carrier that is mountable to a hitch ball as suggested by the reference at column 1, lines 55-57.

Allowable Subject Matter

13. Claims 10-11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 22 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Reasons for Indicated Allowable Matter

14. The following is a statement of reasons for the indication of allowable subject matter:

There are numerous trailer-hitch-receiver mounted step assemblies to be found in the prior art including those in which the step is pivotable from a horizontal orientation for use and a vertical orientation in which it is stowed for non-use, the closest being that due to Hehr (US 6685204). However, none of the prior art devices by themselves nor can a combination be derived from such in which the step assembly is equipped with a mechanism for release of the step from its stowed position by means of a release handle having the structures recited by the limitations of the dependent claims 10, 11 and 22 .

Prior Art made of Record

15. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The prior art of Hamelink et al.; of Cipolla; of Powell; of Osborne, Sr.; of Lippert; of Kimball; of Aldape et al.; and of Smith et al. each show features in common with some of the other structures of the inventive concept disclosed in the instant application.

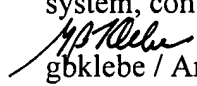
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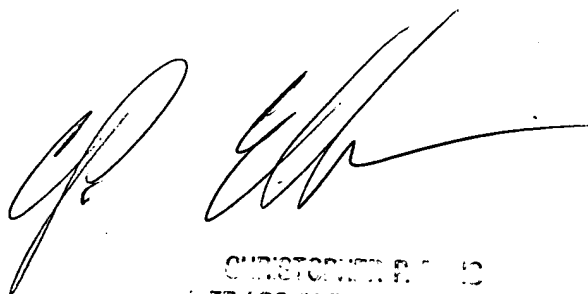
Conclusion

16. Any inquiry concerning this or earlier communication(s) from the examiner should be directed to Gerald B. Klebe at 571-272-6695; Mon.-Fri., 8:00 AM - 4:30 PM ET, or to Supervisory Patent Examiner Christopher P. Ellis, Art Unit 3618, at 571-272-6914.

Official correspondence should be sent to the following TC 3600 Official number as follows: 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


gbklebe / Art Unit 3618 / 19 January 2006



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